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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,979	11/05/2007	Antoni Torrens Jover	283726US0PCT	9435

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EXAMINER	
O DELL, DAVID K	

ART UNIT	PAPER NUMBER
1625	

NOTIFICATION DATE	DELIVERY MODE
03/30/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Claim Rejections/Objections Withdrawn

The rejection of claims 22, 29, are under 35 U.S.C. 103(a) over WO03/0100159 is withdrawn. Applicant's representative has successfully pointed out patentable distinctions between the art and the instant claims. Most importantly the B containing phenyl ring of the instant claims corresponds to the Z containing phenyl ring, not the V, U substituted phenyl ring of the prior art as was cited in the office action. The Z group could be hydroxy which would be a difference of a methylene between the closest species covered by the generic claim when B is CH₂OH. Z can be carboxy, which arguably could be the methyl ester of the instant claims B. The fact that prior art compounds are NMDA receptor antagonists while the instantly claimed compounds are NPY5 receptor ligands deserves some recognition. The paucity of biological data for the working example compounds in the prior art in Tables 1 and 2 point to a different direction in terms of substituent selection for developing further NMDA receptor ligands as most compounds that have activity have a ring fusion on V-U or some sulfonamide type group. A fair reading of the document would not point to the instantly claimed subgenus.

The rejection of claims 22-24, 29, 57-58 under 35 U.S.C. 112, first paragraph, for lacking enablement for "solvate" is withdrawn since the claims have deleted this limitation.

Claim Rejection Maintained

The rejection of claims 22-24, 29, 57-58 under ODP over the 10/566,399 application is maintained. Applicants' representative's attention is directed to MPEP 1490 Part V, Section D.

D. Two or More Copending Applications

If two (or more) pending applications are filed, in each of which a rejection of one claimed invention over the other on the ground of provisional ~~**nonstatutory~~ double patenting (ODP) is proper, the ~~>provisional~~ ODP rejection will be made in each application. If the ~~>provisional~~ ODP rejection is the only rejection remaining in the earlier-filed of the two pending applications, (but the later-filed application is rejectable on other grounds), the examiner should then withdraw

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*>the provisional ODP< rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the >provisional< ODP rejection is the only rejection remaining in the later-filed application, (while the earlier-filed application is rejectable on other grounds), a terminal disclaimer must be required in the later-filed application, before the >provisional< ODP rejection can be withdrawn. If the >provisional< ODP rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the >provisional< ODP rejection in the earlier-filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the >provisional< ODP rejection can be withdrawn and the application be permitted to issue.

>The phrase "earlier-filed" is to be interpreted as follows:

(A) Where there is no benefit claim in the two applications, the "earlier-filed" application is the one having the earlier actual filing date;

(B) Where at least one of the two applications is entitled to the benefit of a U.S. nonprovisional application under 35 U.S.C. 120, 121, or 365(c), the "earlier-filed" application is the one having the earlier effective U.S. filing date, when taking into account each of the benefit claims under 35 U.S.C. 120, 121, and 365(c). Entitlement to the benefit claims under 35 U.S.C. 120, 121 and 365(c) assumes appropriate support in the relied-upon earlier-filed application's disclosure (and any intermediate application(s)) for the conflicting claims of the two (or more) applications;

(C) A 35 U.S.C. 119(e) benefit is NOT taken into account in determining which is the "earlier-filed" application;

(D) A foreign priority claim under 35 U.S.C. 119(a) is NOT taken into account in determining which is the "earlier-filed" application.<

If both applications are filed on the same day, **>the provisional ODP rejection made in each of the applications should be maintained until applicant overcomes the rejections by either filing a reply showing that the claims subject to the provisional ODP rejections are patentably distinct or filing a terminal disclaimer in each of the pending applications.<

Where there are three applications containing claims that conflict such that *>a provisional< ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a *>nonstatutory< double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other.

Particular attention should be paid to the phrase "earlier filed". The filing date of the '399 application is the same as that of the instant case and is 7/29/2004. For this reason the rejection over the '399 application cannot be withdrawn.

*/David K. O'Dell/
Examiner, Art Unit 1625*

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/Rita J. Desai/
Primary Examiner, Art Unit 1625